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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,037	02/18/2000	SYLVAIN ORENGA	105454	7665

7590

02/11/2002

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EXAMINER

FIELDS, IESHA P

ART UNIT

PAPER NUMBER

1645

DATE MAILED: 02/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/486,037

Applicant(s)

ORENGA, SYLVAIN

Examiner

Iesha P Fields

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1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,13-14, and 21-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

DETAILED ACTION

Applicant's amendment received November 5, 2001 (Paper No. 7) has been received and entered. Claims 1, 10, 13-14, and 21-22 were amended and new claims 25-28 were added. Consequently claims 1-28 are pending in the instant application.

Response to Amendment

The text of those sections of Title 35 U.S. Code not included in this action can be found in a prior Office Action.

Claim Objections

Claim 16 objected to under 37 CFR 1.75(c) as being in improper form is **withdrawn** in view of applicant's amendment to the claim.

Claim Rejections

Rejections Under 35 USC § 112

1. Claims 1, 13-14 and 21-22 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention is **maintained**. This rejection is further applied to newly submitted claims 25-28.

Applicants have asserted that the addition of "that is hydrolyzed by the enzyme" provides sufficient description of the function of the "specific portion". Applicants further assert that the "marker portion" clearly refers to the portion that remains after the

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specific portion has been hydrolyzed and thus provides the fluorogenic or chromogenic feature of the substrate.

Applicant's arguments have been carefully considered but not deemed persuasive.

As stated previously, the claims are vague and indefinite in recitation of a "specific portion". The Examiner has noted the incorporation of "that is hydrolyzed by the enzyme" into the claim. However, the amendment is insufficient to overcome the rejection. One of skill in the art would be unable to determine the metes and bounds of such a limitation. Claim 14 recites a substrate that consists of "a specific portion" that is hydrolyzed by "the enzyme". Claim 14 depends on independent claim 13 which recites a medium that comprises an enzyme from the hexosaminidase family. As stated previously, what "specific portion" is being claimed by the applicant? Is a "specific portion" any portion hydrolyzed by an enzyme from the hexosaminidase family? Without a clear definition as to exactly what the applicant is claiming, one of skill in the art would be unable to replicate the claims.

Claims 1 and 21-22 rejected under 35 U.S.C. 112, second paragraph, as being vague and indefinite in recitation of "advantageously essentially" is **withdrawn** in view of Applicants amendment to the claims.

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Claim Rejections - 35 USC § 103

2. Claims 1-24 rejected under 35 U.S.C. 103(a) as being unpatentable over Orenga in view of Pincus is withdrawn in view of Applicants amendments to the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Iesha P Fields whose telephone number is (703) 605-1208. The examiner can normally be reached on 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (703) 308-3909. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Iesha Fields

February 11, 2002


MARK NAVARRO
PRIMARY EXAMINER